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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

EWART, JAMES D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,377

Applicant(s)

MENDIOLA ET AL.

Examiner

James D. Ewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment dated 26 September, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed September 26, 2005 have been fully considered by the Examiner, but are not persuasive.
2. Regarding the arguments that Aravamudan does not teach "automatically allocating a unique identifier to the prospective user", Examiner disagrees. Aravamudan states in Column 6, Lines 52-53 that the "Provisioning server.....provisions the client CPE software with a unique identification (ID)". The user does not request an identification, the server automatically assigns one. Applicant further argues that the user is an existing user at the point in time of the ID being provisioned, the user has not used the system at this point in time and Examiner equates this with prospective user.
3. Regarding the argument that Ilse does not teach a prospective user, Examiner disagrees. In order for a user to access the Electronic Provider-Patient Interface (ePPi) System, he or she must be assigned a users name and a password which is provided by the ePPi system after the user has provided required information i.e. registration see Column 30, Lines 9 - 36.
4. Regarding Applicant's argument that "inviting registration" is not taught, Examiner agrees. However, the claim indicates a "direct request" or "inviting registration" and the Examiner cites a "direct request".

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5. Both Aravamudan and Ilsen are in the same field of endeavor as they discuss the process of a prospective user becoming a user of a computer service. The reason to combine is simply an alternative to a user selecting a user name and is desirable so that a user does not have to spend time trying to get a user name that does not match any existing names as the computer already has that information.

6. Regarding claims 3 and 12, Examiner has used the Gerace reference to only show the teaching of a unique identifier being a UIN. The motivation to combine is to distinguish one user from another.

7. Regarding claims 4 and 14, The Examiner equates the SMS messaging system using an e-mail address to identify the user with an "e-mail based client application" and the reason to combine is to distinguish the SMS user from the other users.

8. Regarding claims 5, 6, 15 and 16 Examiner has used the McDowell et al reference to only show the teaching of a GSM network and device for accessing the IM system. The motivation to combine is to provide a connection to the internet.

9. Regarding claims 7,9,10,13,17 and 19, Examiner has used the Patil reference to only show the teaching of sending information via e-mail and sending a message to an IM server from a registered user. The motivation to combine is to enhance the currently available messaging capabilities of SMS.

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10. Regarding claims 8, 18 and 20, Examiner has used the Smith et al reference to only show the teaching of sending an e-mail address to the e-mail address of a registered user on an IM server. The motivation to combine is to integrate different types of messages from different types of equipment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3 and 11 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al. (U.S. Patent No 6,301,609) in view of Ilsen et al (U.S. Patent No 6,757,898)

Referring to claims 1 and 11, Aravamudan et al. teaches a method for assigning a unique identifier to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types (Figure 1, 140), selectively interconnected to an IM server by way of a computer network (Figure 1, 122), the method comprising the following steps: receiving a client specific access address of a prospective user on the computer network with a request to register or tentatively register an account for said prospective user (Column 6, Lines 32-45); automatically allocating a unique identifier to the prospective user (Column 6, Lines 50-55); matching said unique identifier to the client specific access address of

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the prospective user (Column 6, Lines 58-63) and registering or tentatively registering an account for said prospective user by storing the matched unique identifier and client specific access address with said IM server under the unique identifier (Column 6, Lines 58-63), but does not teach sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either confirming the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial receiving was associated with a request to register from someone other than the prospective user. Ilsen et al. teaches sending notification of said unique identifier to said prospective user at the client specific address of the prospective user (Column 30, Lines 25-26), either confirming the registration of the prospective user if the initial receiving was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial receiving was associated with a request to register from someone other than the prospective user (Column 30, Lines 22-26). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of McDowell et al with the teaching of Ilsen et al. of sending notification of said unique identifier to said prospective user at the client specific address of the prospective user, either confirming the registration of the prospective user if the initial sending was associated with a direct request to register from the prospective user; or inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user in cases where unique identifiers of user information are not met (Column 30, Lines 22-26).

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Referring to claim 3, Aravamudan et al. further teaches wherein said computer network is the internet and/or any direct electronic link (Column 3, Lines 39-40).

12. Claim 2 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al. and Ilsen et al and further in view of Gerace (U.S. Patent No. 5,848,396).

Referring to claim 2, Aravamudan et al. and Ilsen et al teach the limitations of claim 2, but do not teach wherein the unique identifier is a UIN. Gerace teaches wherein the unique identifier is a UIN (Column 6, Lines 23-24). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al. and Ilsen et al with the teaching of Gerace wherein the unique identifier is a UIN to distinguish one user from another (Column 6, Lines 35-40).

13. Claim 4 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al. and Ilsen et al and further in view of Kraft (U.S. Patent No. 6,309,305).

Referring to claim 4, Aravamudan et al. and Ilsen et al teach the limitations of claim 4 but do not teach wherein the prospective user has an email-based client application for accessing the messaging system. Kraft teaches wherein the prospective user has an email-based client application for accessing the messaging system (Column 5, Lines 13-19). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al. and Ilsen et al with the teaching of Kraft wherein the

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prospective user has an email-based client application for accessing the messaging system to define a sender (Column 5, Line 18).

14. Claims 5 and 6 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al. and Ilsen et al and further in view of McDowell et al. (U.S. Patent Publication No. 2001/0034224).

Referring to claim 5, Aravamudan et al. and Ilsen et al teach the limitations of claim 5 but do not teach wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system. McDowell et al teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al. and Ilsen et al with the teaching of McDowell et al wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system to provide a connection to the internet (0014).

Referring to claim 6, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

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15. Claims 7, 9, 10, 13, 17, and 19 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al. and Ilsen et al and further in view of Patil (U.S. Patent No. 6,625,460).

Referring to claims 7, 9, 17 and 19, Aravamudan et al. and Ilsen et al teach the limitations of claims 7 and 9 including wherein the prospective user sends client specific address to a web page, but do not teach sending information via e-mail. Patil teaches sending information via e-mail (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al. and Ilsen et al with the teaching of Patil of sending information via e-mail to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

Referring to claim 10, Aravamudan et al. and Ilsen et al teach the limitations of claim 10 including wherein said client specific address is sourced from a web page, but do not teach sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server. Patil teaches sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al. and Ilsen et al with the teaching of Patil of sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

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Referring to claim 13, Aravamudan et al. further teaches wherein said computer network is the internet and/or any direct electronic link (Column 3, Lines 39-40).

16. Claim 8 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al and Ilsen et al and further in view of Smith et al. (U.S. Patent No. 6,333,973).

Referring to claim 8, Aravamudan et al and Ilsen et al teach the limitations of claim 8, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al and Ilsen et al with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20).

17. Claim 12 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Patil and further in view of Gerace.

Referring to claim 12, Aravamudan et al., Ilsen et al and Patil teach the limitations of claim 12, but do not teach wherein the unique identifier is a UIN. Gerace teaches wherein the unique identifier is a UIN (Column 6, Lines 23-24). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of

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Aravamudan et al., Ilsen et al and Patil with the teaching of Gerace wherein the unique identifier is a UIN to distinguish one user from another (Column 6, Lines 35-40).

18. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Patil and further in view of Kraft.

Referring to claim 14, Aravamudan et al., Ilsen et al and Patil teach the limitations of claim 14, but do not teach wherein the prospective user has an email-based client application for accessing the messaging system. Kraft teaches wherein the prospective user has an email-based client application for accessing the messaging system (Column 5, Lines 13-19). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Aravamudan et al., Ilsen et al and Patil with the teaching of Kraft wherein the prospective user has an email-based client application for accessing the messaging system to define a sender (Column 5, Line 18).

19. Claims 15 and 16 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al., Ilsen et al and Patil and further in view of McDowell et al.

Referring to claim 15, Aravamudan et al. and Ilsen et al teach the limitations of claim 15 but do not teach wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system. McDowell et al teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art

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to combine the teaching of Aravamudan et al. and Ilsen et al with the teaching of McDowell et al wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system to provide a connection to the internet (0014).

Referring to claim 16, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

20. Claims 18 and 20 are rejected under 35 USC 103(a) as being unpatentable over Aravamudan et al, Ilsen et al and Patil and further in view of Smith et al.

Referring to claims 18 and 20, Aravamudan et al, Ilsen et al and Patil teach the limitations of claims 18 and 20, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Aravamudan et al, Ilsen et al and Patil with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20).

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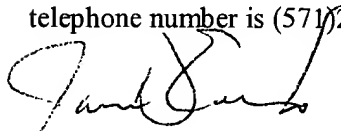
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Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on (571)272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2600.


Ewart
October 17, 2005


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